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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/017,728   | 12/14/2001  | Joshua S. Auerbach   | GB920010099US1      | 5443             |
| 46320  | 7590        | 04/25/2006           | EXAMINER            |                  |
| CAREY, RODRIGUEZ, GREENBERG & PAUL, LLP<br>1300 CORPORATE CENTER WAY<br>SUITE 105G<br>WELLINGTON, FL 33414 |             |                      | BLAIR, DOUGLAS B    |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 2142                |                  |

DATE MAILED: 04/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/017,728

Applicant(s)

AUERBACH ET AL

Examiner

Douglas B. Blair

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 8-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. Claims 8-15 are currently in pending in this application.
2. The cancellation of claim 1-7 has satisfied the Request For Information requirement previously presented to the applicant since the Request For Information was directed solely to the subject matter of claim 1-7.

### ***Response to Arguments***

3. Applicant's arguments, see Pre-Appeal Brief Request for Review, filed 11/25/2005, with respect to the rejection(s) of claim(s) 8-14 under 35 U.S.C. section 102 as failing to comply with rule 37 C.F.R. section 1.104(c) have been fully considered and are persuasive. The argument that the rejection does not comply with CFR 1.104 implies that the reference was too complex for the applicant to understand without a clear explanation from the Examiner. The Examiner apologizes for "forcing" the applicant to "engage in mind reading". Therefore, the rejection, as previously written, has been withdrawn. However, upon further consideration, new rejections are made in view of Herz and 35 U.S.C. section 112 2<sup>nd</sup> paragraph.
4. The rejection based on Herz has been written to more clearly pointing out all specific elements. As the remainder of the applicant's arguments center around the applicant's confusion with the complexity of Herz, the newly written rejection should clarify the Examiner's interpretation and render these arguments moot. The rejection based on 112 2<sup>nd</sup> paragraph, has been raised based on a careful study of the claim language in light of the applicant's arguments.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 8, 10, 12, and 14 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claim 8 recites the limitation "the publication received" in the fourth limitation of the claim. Specifically, the preamble mentions that publications are received but never specifies a specific publication to compare to the subscription request. There is insufficient antecedent basis for this limitation in the claim. For examination purposes it will be assumed that the claim language was meant to compare the received publications rather than one specific publication.

8. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: it is unclear whether the "at least part of an attribute" specified in the second limitation of the claim is supposed to be the "at least one attribute" of the filter expression found in the first limitation of the claim.

9. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: the fourth limitation states that a comparison is made to determine whether the publication is appropriate for forwarding to the subscriber however no comparison is ever defined by the claim; the step of "transmitting said publication to the

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originating subscriber” happens regardless in claim 8 so therefore there is no determination of what is appropriate for a subscriber being made in the claim.

10. Claim 8 recites the limitation "the generic format filter attribute" in the second to last limitation of the claim. It is unclear whether this generic format filter attribute is referring to the one defined by the second limitation of the claim or the one defined by the directly preceding limitation or if these two limitations are even referring to the claim generic format filter attribute. There is insufficient antecedent basis for this limitation in the claim.

11. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: said first type of message is defined to be a subscription request and said second type of message is defined to be a publication message so it's unclear how the two different types of messages are combined or by what. The specification gives no guidance to aid in the interpretation of this limitation as there is no explanation of how information of one type of message is input into another type of message or even why this is done.

12. Claim 12 recites the limitation "said generic format filter attribute". As discussed above, it is unclear as to what this limitation is referring to: attributes of the subscribe request or those of the publication message. There is insufficient antecedent basis for this limitation in the claim.

13. Claim 14 recites the limitation "said format". There is no format discussed previously in any of the claims 14 depends on. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

15. Claims 8-15 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Number 6,460,036 to Herz.

16. As to claim 8, Herz teaches a method for receiving publications and forwarding said publications on to parties who have subscribed to receive such publications, said method comprising:

receiving a subscription request of a first type, said request including a filter expression having at least one attribute (**col. 4, line 49-col. 5, line 7, the search profile or query contains keywords and target objects to request publications of interest**);

mapping at least a part of an attribute to a generic format (**col. 57, lines 39-51, the search profiles are mapped to generic cluster profiles**);

receiving a publication message of a second type (**col. 4, lines 49-col. 5, line 7, the target profile**);

comparing a publication received with the subscription request to determine whether the publication is appropriate for forwarding onto the subscriber originating the request (**col. 57,**

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lines 8-36, the search profile is compared with the target profile), the step of comparing comprising:

identifying a generic format filter attribute (cols. 57 and 58, the target profile); mapping the generic format filter attribute to a format corresponding to the second message type (col. 57, line 53-67, the target profiles are mapped to target profile cluster trees), the method further comprising:

transmitting said publication to the originating subscriber (col. 58, lines 25-54, the list of articles is presented to the user.).

17. As to claim 9, Herz teaches the communications manager of claim 8, further comprising preparing the publication for transmission to said originating subscriber (col. 58, lines 25-54, the list of articles are prepared for the user.).

18. As to claim 10, Herz teaches the communications manager of claim 9, comprising: creating a substantially empty message of said first type (the search profiles can contain few keywords or target objects); extracting information from the message of said second type (attributes are examined from the target profiles).

19. As to claim 11, Herz teaches the communications manager of claim 8, 9, or 10, wherein said mapping at least part of an attribute to a generic format comprises: invoking a first component capable of understanding messages of said first type (the search profiles are analyzed as described above).

20. As to claim 12, Herz teaches the communications manager claims 8, 9, or 10 comprising: storing said generic format filter attribute (col. 56, line 49-col. 57, line 5).

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21. As to claim 13, Herz teaches the communications manager of any preceding claim, wherein said mapping a generic format filter attribute to a format corresponding to the second message type comprises: invoking a second component capable understanding messages of said second type **(the target profiles are analyzed as described above)**.

22. As to claim 14, Herz teaches the communications manager of any preceding claim, wherein said format corresponding to the second message type is held in temporary storage until said comparison is complete **(col. 56, line 49-col. 57, line 5)**.

23. As to claim 15, Herz teaches a computer embodiment.

### ***Claim Objections***

24. Claim 15 is still objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend upon a multi-dependent claim. See MPEP § 608.01(n). Accordingly, the claim 15 has not been further treated on the merits.

### ***Conclusion***

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas B. Blair whose telephone number is 571-272-3893. The examiner can normally be reached on 8:30am-5pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on 571-272-3868. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

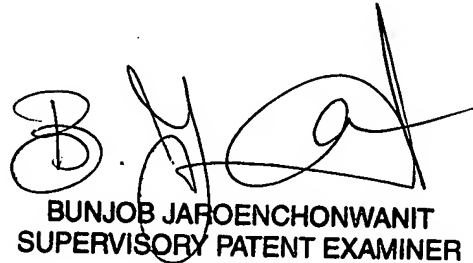


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Douglas Blair

DBB



BUNJOB JAROENCHONWANIT  
SUPERVISORY PATENT EXAMINER